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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/737,579      | 12/18/2000  | Tomoko Ishikawa      | 199648US0           | 9891             |

22850 7590 08/14/2003

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ALEXANDRIA, VA 22314

EXAMINER

NOTE, JANIS L

ART UNIT PAPER NUMBER

1756

DATE MAILED: 08/14/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.



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| 09/731579          |             |                       |                     |  |
| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |  |

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Below is a communication from the EXAMINER in charge of this application  
COMMISSIONER OF PATENTS AND TRADEMARKS

### ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.  
Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

#### PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
  - (b) ☐ they raise the issue of new matter. (see NOTE below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

See attached paragraph 1.

4. ☐ Applicant's reply has overcome the following rejection(s):

5. ☒ Newly proposed or amended claim(s) 27-30, 32, 34, 37, 38, 40, 42 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached paragraph 2
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: 44

Claim(s) rejected: 27-30, 32, 34, 37, 38, 40, 42

Claim(s) withdrawn from consideration: 1-26, 31, 33, 35, 36, 39, 41, 43, 45-56

9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☒ Other: see attached.

*Janis L. Dote*  
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GROUP 1-4  
1900

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1. The subject matter recited in proposed new claims 57-67 raises new issues due to the limitation "wherein the binder resin comprises units from a monomer having a Bronsted acidic group or a Bronsted basic group." Said limitation was not presented in elected claims 27-30, 32, 34, 37, 38, 40, 42, and 44, at the time the final rejection in Paper No. 14 was mailed on Apr. 4, 2003.

2. The examiner's refusal to enter the amendment filed after the final rejection in Paper No. 15 on July 20, 2003, renders applicants' arguments moot. The rejections of claims 27-30, 32, 34, 37, 38, 40, and 42 over Matsuoka stand for the reasons discussed in the final rejection in Paper No. 14.

With respect to the objection to the specification set forth in Paper No. 14, paragraph 4, applicants assert that capitalization of trademarks is not a requirement because section 608.1(v) of the MPEP 608.1(v) states that "trademarks should be identified by capitalizing each letter of the mark" (emphasis in the original).

However, section 608.01(v) of the MPEP further states that "the proprietary nature of the marks should be respected . . . Every effort should be made to prevent their use in any manner which might adversely affect their validity as trademarks." MPEP 608.01(V), 8th ed., Rev. 1, Feb. 2000, in particular page 600-84, lines 33-41. Thus, to respect the proprietary nature of the

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Art Unit: 1756

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trademarks cited in the instant specification, the objection stands.

Applicants are remained that if they do not agree with the objection, they may file a petition under 37 CFR 1.113 to the Director to remove the objection. MPEP, chapter 1000.